

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Kenneth B. Allbriton

Serial No.: 09/995,615

Examiner: MAI, TRI M.

Filed: 29 November 2001

Art Unit: 3727

For: SPORTS EQUIPMENT BAG, ORGANIZER AND VENTILATOR

PETITION UNDER 37 C.F.R. §1.144

Mail Stop Petitions

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

Pursuant to 37 C.F.R. §1.144, the Commissioner is respectfully requested to review the restriction requirement mailed by the Examiner on October 18, 2002 (Paper No. 5).

Folio: P56341

Date: 11/10/3

I.D.: REB/FJD/kf

STATEMENT OF FACTS

1. Applicant filed an application on November 29, 2001 containing apparatus Claims 1 through 34 which described a here-to-for unavailable bag for use as a sports equipment bag, organizer and ventilator.
2. On October 18, 2002, the Examiner issued a restriction requirement (Paper No. 5) where the Examiner required that an election be made between 16 Groups as decided by the Examiner containing Claims 1 through 34.
3. On November 18, 2002, the Applicant filed a response to the election requirement and an amendment. The amendment added new claims 35 through 40, and amended claims 10 and 21. With regard to the election requirement applicant provisionally elected species VI (figures 8 and 10) with traverse. Applicant questioned several actions of the Examiner including the imposition of a requirement for restriction where the application does not contain a generic claim as was the case here..
4. On December 30, 2002 the Examiner issued an Office Action stating that Applicant's traversal of paper number 7 was treated as an election without traverse since no reasons were given by the applicant. The requirement was made final.
5. On March 31, 03, Applicant filed an amendment under 37 C.F.R.Sec.1.111 requesting re-examination, reconsideration, and entry of the amendments. Claims 24 through 27 were amended as were claims 35 and 37. Claim 36 was cancelled.
6. On May 16, 2003 Applicant filed a supplemental amendment which added new

ARGUMENT

1. Traversal

The Examiner notes that the traversal is timely traversed, but stated that as set forth in Paper No. 6 is not a traversal of the propriety of the requirement per se, but only related to whether certain claims are designated as generic or not, so the Examiner states that the election will be treated without traversal since no reasons traversing the propriety of the requirement were set forth by the Applicant.

The Applicant strongly objects to the statement that election was made without traversal.

The Applicant laid out an array of reasons explaining why the restriction and election of species was improper. The Applicant directly made arguments concerning the restriction requirement.

The Examiner stated that the arguments only related to whether certain claims are designated as generic and not to the propriety of the requirement.

However, the Applicant argued in point 4 in paper number 7 that the general test for restriction of species was not met. Clearly that pertains to the restriction and election of species. Further, in point 5 of paper number 7, the Applicant argued that the Examiner failed to meet requirements set forth by MPEP §803 (entitled "Restriction when proper") where the Examiner must show that the inventions are independent or distinct and that there is a serious burden on the Examiner. The Applicant then goes on in page 7 of paper number 7 showing how the Examiner has failed to show a burden. For example, failing to show that different embodiments are in

different classes. Paper number 7 continues to point out that in paper number 5, the Examiner did not allege in any way a serious burden. Further, Applicant goes on to state why the Examiner should not have a serious burden by giving examples of how claims cover multiple species. Questioning the burden on the Examiner is clearly by itself a proper reason for traversal as highlighted by MPEP §803 on the propriety of restrictions.

Clearly as shown above, the Applicant in paper number 7 made a provisional election with traverse.

2. MPEP §803 Restriction when proper

As the Applicant mentioned in paper number 7, the Applicant states again that as cited in MPEP § 803, the examiner must show that the (A) The inventions must be independent (see MPEP § 802.01, § 806.04, § 808.01) or distinct as claimed (see MPEP §806.05 - §806.05(i)); **and** (B) There must be a **serious burden** on the examiner if restriction is required (see MPEP §803.02, § 806.04(a) -§806.04(i), §808.01(a), and § 808.02).

The examiner must prove that the inventions are independent or distinct and that there is a serious burden on the examiner.

It is respectfully submitted that there would not be a serious burden upon the examiner in searching the invention species I through XVI.

First the Examiner has failed to show any kind of burden. The Examiner has failed to show that the different embodiments are in different classes for example. As stipulated in *MPEP* §803,

if the search can be made without serious burden, the Examiner must examine it on the merits even if there are separate and distinct inventions. The Examiner has not alleged any serious burden in Paper No. 5 dated 18 October 2002 and thus the Examiner must examine the entire application.

Secondly, as seen above, for example, in species VI, claim 24 is also in species VIII. Further, claim 10 (species III) is dependent on claim 1 which has the features of species I and II for example. Claim 12 has the features of both species I and species II. Therefore, there would be no serious burden on the Examiner and as required by *MPEP* §803, the Examiner must examine the entire application on the merits.

The Examiner on page 2 of paper number 8 states that regarding the burden, "it is noted that each of the disclosed species require a separate search exclusively for that species before patentability of the claims readable on that species can be considered. Moreover, the searches for the disclosed species are not necessarily coincident." The Examiner mentioned general statements but provided no proof of the burden such as giving examples of different classes for the different embodiments and an example of why the species are not coincident. It is the Examiner's burden of proof to provide examples of a serious burden under *MPEP* §803. These safeguards are set by the USPTO to ensure that an inventor is given due process without arbitrary and convenient judgements.

3. Provisionally elected group

Further concerning the provisionally elected species, the Examiner gave a choice of group VI being figures 8 and 10 and group VIII being 8 and 11. However, figure 10 (backpack 710) is only a closed view of the backpack of figure 8 (backpack 710) which is also the backpack of figure 11 (backpack 710). As mentioned at the top of paragraph 60, "Looking at Fig. 11, the backpack 710 (and also on bag 810) can have also a strap 752 secured to the top of the bag 710 that allows for clothes hangers to hang for jerseys or street clothes." It specifically refers to backpack 710 which is the backpack in figure 8 (backpack 710). Further, figure 10 is only the backpack 710 (figures 8, 11) in the closed position as mentioned specifically on page 17, paragraph 61, first sentence, "As seen in Fig. 10, the backpack 710 is in a closed position." Therefore, the provisionally elected group should also include figure 11 as supported by the specification.

As stipulated in MPEP §803, if the search can be made without serious burden, the Examiner must examine on the merits. The Examiner has not shown any serious burden, therefore, the Examiner must examine the entire application.

RELIEF REQUESTED

In view of the above, the Commissioner is respectfully requested to:

- A. Withdraw the Restriction Requirement imposed on 18 Oct. '02. (Paper No. 5)
- B. Such other and further relief as justice may require be granted.

Respectfully submitted,



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For: SPORTS EQUIPMENT BAG, ORGANIZER AND VENTILATOR

**PROPOSED AFFIDAVIT OF COMMERCIAL SUCCESS
TO BE SUBMITTED AT THE OFFICE INTERVIEW**

Commissioner for Patents
P.O.Box 1450
Alexandria, VA 22313-1450

Sir:

I. This paper is submitted in accordance with MPEP 716.02(g) and as provided by 35 U.S.C. 25 and 18 U.S.C. 1001.

II. Applicant submits that the attached evidence provided by the Applicant, consisting of product awards and invoices of sales of the item covered by claims 24-27, 32-35, and 37-44 of the above cited US Patent Application, claim 24 as an example reproduced below, comprises a nexus between the claimed invention and evidence of commercial success.

Claim 24. (Previously Amended) *A bag, comprising of:*

a back wall;

a first unit connected to a top side of said back wall, said first unit capable of hanging said back wall to an external object, the external object being external to said bag;

a plurality of compartments on a front surface of said back wall, the plurality of compartments including a front portion comprising of netted material accommodating a

circulation of air within said compartments, said compartments accommodating a plurality of objects;

a pair of straps disposed a predetermined distance from each other along the longitudinal side of a bottom portion of the back surface of said back wall to accommodate a carrying of said bag on the back of a user; and

a fastening unit securing one end [of] said back wall with the other end when said back wall is folded.

Gearmax™

By:

_____ 2003
(Date)

_____ (Seal)
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